

Amendments to the Drawings:

The attached sheets of drawings includes changes to Figs. 2 and 5.

The new replacement sheet that includes Figs. 1-3 replaces the previous replacement sheet that included Figs. 1-3.

The new replacement sheet that includes Figs. 4-5 replaces the previous replacement sheet that included Figs. 4-5.

Attachment: Replacement Sheets

REMARKS/ARGUMENTS

Reply to the Examiner's Response to Arguments

Applicant disagrees with the Examiner's comments in Section 1 (page 2) of the Office Action wherein the Examiner makes the statement that the lip 52 would inherently experience the radial movement and downward movement. Applicant does not believe there is any disclosure that lip 52 moves radially. Even if it did, a combination of radial movement and downward movement does not necessarily equate to rolling. A lip could move in a linear manner both radially and downwardly and experience no rolling movement at all.

Election/Restrictions

The Examiner has withdrawn claim 26 from consideration as being directed to a non-elected invention, namely arguing that new claim 26 relates to the embodiment shown in Figures 1 to 4 and not the embodiment shown in Figures 5 to 7. Applicant disagrees and hereby traverses.

To substantiate a proper restriction of claims in an application, the Examiner has the burden of (1) showing that the application claims independent or distinct inventions (as required by both §121 and the USPTO rules), and (2) that examining all claimed inventions in a single application would constitute a serious burden. See MPEP §803. The Examiner does none of this, instead merely says that the feature is "directed to the non-elected species of Fig. 1-4."

Withdrawn (by the Examiner) claim 26, was drafted to include the features from the final sentence of paragraph [0030] of the Application as they relate to the embodiment of Figures 5 to 7. This paragraph discloses that the lip rolls sufficiently to form a tube contacting the flange. Paragraph [0032] (referring to Figures 5 to 7), states that "each of which is constructed in and functions in a similar manner to the corresponding parts of the seal of Figures 1 to 4." The flange 20 and the shoulder 120 are interchangeable and as such, the features claimed in claim 26 could be present in either of the Species.

As such, claim 26 should not have been withdrawn and it is completely appropriate for claim 26 to be examined at this time. Applicant asks that the restriction be lifted.

Amendments in General

Replacement sheets of drawings are attached which address the Examiner's drawing objections. Changes consistent therewith were made to Fig. 2 and Fig. 5. No new matter is added.

Claim Rejections - 35 USC § 112

Claims 1-3, 5-9, 11-20 and 24 were rejected under §112, 1st paragraph because the Examiner argues that while there is support for the lip rolling in a predictable manner, there is no support for the lip rolling in a “controlled manner” as claimed in claim 1.

Applicant disagrees, but in the interest of expedient prosecution has amended claim 1 to remove “and controlled” thereby rendering the objection moot.

Claims 1-3, 5-9, 11-20 and 24 were rejected under §112, 2nd paragraph.

Applicant’s amendment to claim 1 renders this objection moot as well.

Claim Rejections - 35 USC § 102

The Examiner rejected pending claims 1-3, 5-9, 11-13, 16-18, 20, 24 and 25 under 35 USC §102(b) as being anticipated by WO 00/09825 (“Atkins”), noting that Atkins has a deformable lip that is “arranged such that the sealing face of the lip would inherently deform by a radially outer portion of the lip rolling in a predictable ... manner when subject to axial compression.”

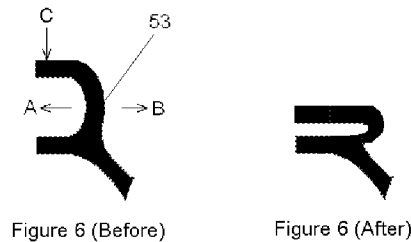
[Note: The “Atkins” reference (WO 00/09825) is referred to herein as “Atkins.” This should not be confused with the fact that the first named inventor on this (10/625,300) application is the same Nicholas Atkins. For sake of clarity, any reference to “Atkins” in this Response will be in reference to the “Atkins” reference (WO 00/09825) and not to the present application, which will be referred to as the Application.]

Applicant respectfully disagrees with the Examiner’s analysis.

In Atkins, the description of Figure 6 describes the portion 53 as “collapsing, either radially inwards or outwards...” (Atkins, p. 13, l. 31 - p. 14, l. 8). First, how can anything “collapse” in a controlled and predictable manner? Second, Atkins indicates that the lip can collapse “either radially inwards or outwards.” Such an “either/or” collapse is not “predictable.” Atkins does not show what the Examiner says it shows.

Atkins shows collapsing. The Application shows rolling. Rolling and collapsing are not the same thing.

Further, Atkins is configured (structurally) for collapsing. An illustration of what the Applicant's counsel believes this collapse looks like in Atkins follows:



Atkins states that when the toilet acts against the seal, the "vertical body member 53 will tend to collapse by either radially inward or outward compression thus allowing the upper disc member 52 to move towards the lower disc member 54 such that they are compressed together to form the seal." Applicant's counsel interprets that to mean that when subject to a force, the vertical wall 53 will move in the direction of arrow A or arrow B on the attached drawing. This means that the upper disc 52 moves vertically downwards in the direction of arrow C to the position shown in Figure 6A. Atkins does not roll...it collapses.

In contrast to the Application's "rolling," Atkins physical structure makes it impossible for Atkins to roll. Refer to Atkins Fig. 6. Rolling would cause the lower horizontal member 54 to move off the upper flange portion 10A (shown in Fig. 1). If the lower horizontal member "rolled" away from the upper flange portion (as the Examiner proposes), the seal of the "horizontal sealing surface of the outer ring" would be broken, thereby rendering Atkins device ineffective for its intended purpose (sealing a toilet flange). Atkins MUST collapse to work. Atkins cannot roll.

Further, the Examiner is directed to examine the structure of Atkins that supports the rim. It is thin and bowed outwards. The exact type of structure you would expect to find on a collapsible structure. Atkins is configured to collapse, not roll.

For these reasons, it is Applicant's position that the claims are not anticipated by Atkins and the Applicant respectfully asks the Examiner to withdraw the rejections previously made.

Claim Rejections - 35 USC § 103

The Examiner rejected claims 14, 15, 19 and 25 under §103(a) as being unpatentable (obvious) in view of Atkins (WO 00/09825).

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

combine reference teachings. Second, there must be a reasonable expectation of success. ***Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.*** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP § 706.02(j). (emphasis added).

As discussed above, the claims of the present invention (as amended) are not anticipated by the prior art. Therefore, a prima facie case of obviousness has not been made.

Furthermore, the recent Supreme Court decision of *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (2007) reminds us that "mere speculation is not enough; factual support for the Examiner's position needs to appear in the cited prior art and not derived from applicant's specification." The Examiner needs to specifically identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. Such support is not present in the Examiner's Action. As such, the rejection regarding obviousness should either be withdrawn or the Examiner should provide factual support for his arguments.

CONCLUSION

Entrance of these amendments as well as the consideration and allowance of the application as amended is respectfully requested. If the Examiner has any questions in regard to this Response, the Examiner is invited to phone the undersigned below.

DATED this 15th day of May, 2007.

Very respectfully,

/Stephen M. Nipper/
STEPHEN M. NIPPER
Reg. No. 46,260
(208) 345-1122

CERTIFICATE OF EFS-WEB TRANSMISSION UNDER 37 CFR 1.8

I HEREBY CERTIFY that this correspondence is being transmitted to the United States Patent and Trademark Office by EFS-Web on the date below.

DATED: This 15th day of May, 2007.

/Julie L. O'Tyson/

Julie O'Tyson
Phone: 208-345-1122